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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,010	05/29/2001	Tetsuji Yamaguchi	83300.0003	8423
26021	7590	01/03/2005	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			PENDERGRASS, KYLE M	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/870,010	Applicant(s) YAMAGUCHI ET AL.	
	Examiner Kyle M Pendergrass	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/19/01</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 & 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Hidaka et al. (US 6,782,402).

Regarding claim 1, Hidaka et al., teach a system of managing image data in a network (*Figure 1*, copy system 1 comprises a copy server 10, a scanner 20 and a printer 21.), comprising:

an image input device (*Figure 1*, scanner 20);

an image forming device (*Figure 1*, printer 21);

a network connecting for at least one of the image input device and the image forming device (*Column 10, lines 1-9, & Figure 1*, copy system 1 consisting of scanner 20 and printer 21 is connected to the network NW);

a storage means for storing image data inputted by the image input device (*Column 10, lines 33-54*, copy server controls the reception of scan data from the scanner 20, and the image file area 134 stores various types of image files);

and a client computer, connected to the network (*Figure 1*, client terminal 2), for managing the image data stored in the storage means via the network (*Column 10, lines 25-32, & Figure 1*, client terminal 2 communicates data exchange, via the network, with communication device 14 in copy system 1 to manage the image data stored in the image file area 134).

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Note also that storage means in the image forming device, although not mentioned specifically by Hidaka et al., is essential if printer 21 is to function. Therefore, storage means in an image forming device is inherent to the teachings of Hidaka et al.

Claim 3 recites identical features as apparatus claim 1, except claim 3 is a method claim. Thus, arguments similar to that presented above for claim 1 are equally applicable to claim 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 & 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidaka et al. (US 6,782,402) & Kurachi (US 6,181,436).

Regarding claim 2, Hidaka et al., teach the system according to claim 1. Hidaka et al., further teach the image forming device including a network interface (Hidaka et al., *Figure 1*, printer 21 interfaces through copy server 10 with network NW). Hidaka et al. do not teach an image forming device including a storage means or a converter for converting and storing binary and text data, although their teachings include a converter and storage means included in the copy server 10.

However, Kurachi teaches a printer with storage means and a converter means (*Figure 3*, printer contains print data converting device 3d, print data storing device 3b, and rough image storing device 3g). *Figure 1* shows the direction of data, wherein binary print data is inputted into the printer, stored and converted to text/image print job data which is released to the client apparatuses through the network. Kurachi also teaches the network interface 12 to include a software for managing the text data, and transmits the text data stored in the text data storage section to the client computer (*column 7:lines 35-40*).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the Kurachi data exchange system with the Hidaka et al., system because the teachings of Kurachi would allow the printer to do the job of the copy server 10, thus reducing the amount of parts in the Hidaka et al., system.

Claim 4 recites identical features as apparatus claim 2, except claim 4 is a method claim. Thus, arguments similar to that presented above for claim 2 are equally applicable to claim 4.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Pendergrass whose telephone number is (703) 306-3445. The examiner can normally be reached on Monday-Friday 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application of proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

A handwritten signature in black ink, appearing to read "King Y. Poon". The signature is fluid and cursive, with the first name "King" and last name "Poon" clearly distinguishable.

**KING Y. POON
PRIMARY EXAMINER**